

REMARKS

By this Amendment After Final, Applicant has canceled claims 1-28 and 39-43 without prejudice or disclaimer. No new matter has been added. Claims 44-49 are pending.

In the final Office Action, claims 1-28, 39, and 40 were rejected under either 35 U.S.C. § 102(b) or under § 103(a) based on Chono et al. (JP 8-50452) either alone or in combination with Ovadia et al. In addition, claims 41-49 were rejected under either 35 U.S.C. § 102(b) or under § 103(a) based on Chono et al. alone. By this Amendment After Final, Applicant has canceled claims 1-28 and 39-43 without prejudice or disclaimer, such that only claims 44-49 remain pending in this application, thereby obviating the above-outlined rejections of claims 1-28 and 39-43. Claims 44-49 were rejected under 35 U.S.C. § 103(a) based on Chono et al. Applicant respectfully traverses that rejection at least because there is no suggestion or motivation to make the final Office Action's proposed hypothetical modification to the Chono et al. reference, as will be explained in more detail below.

In the final Office Action, the rejection statement asserts that "Chono et al anticipate a box comprising a body formed from a blank that is precut with score lines and folded to form the body (p.13, paragraphs 24-25 of translation and Fig. 5)," and further, that "[t]he blank comprises a support having a first surface and a second surface, wherein the outer surface has printing thereon, and at least one sheet of non-woven material arranged on the outer surface by adhesive, in which the non-woven material is partially transparent so that the printing on the support is visible through the non-woven material (see abstract)." Final Office Action at 5. The rejection statement

acknowledges that “Chono et al fail to teach adding a second layer exactly like the first layer of printing and non-woven material arranged by adhesive bonding to the outer surface of the box, also to the inner surface of the box, in order to provide aesthetic appeal to the surface as well as the outer surface.” Id. at 5-6. The rejection statement, however, asserts that “for the same reasons printing and a non-woven material are attached to the outer surface of the box, printing and a non-woven material would be added to in [sic] the inner surface of the box, especially for aesthetic appeal.” Id. at 6. Thereafter, the rejection statement asserts that “it would have been obvious to . . . add printing and a non-woven material to the inner surface of the box, that performs the same purpose as the printing and non-woven material on the outer surface of the box, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.” Id. at 6 (citing St. Regis Paper Co. v. Bemis Co., 549 F.2d 833; 193 U.S.P.Q. (BNA) 8 (7th Cir. 1977)). Applicant respectfully traverses the rejection statement’s conclusion at least because it fails to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143. In addition, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings.” Id.

The Section 103 rejection of claims 44-49 based on Chono et al. fails to establish a *prima facie* case of obviousness at least because the final Office Action has not set forth any suggestion or motivation having a basis in the cited references or any other

legally proper source for making the rejection statement's proposed hypothetical modification to Chono et al. Rather, the final Office Action appears to be relying on hindsight and the teaching of Applicant's own disclosure to find the suggestion or motivation needed to modify Chono et al. in the rejection statement's proposed hypothetical manner. Furthermore, Applicant respectfully traverses the rejection statement's assertion that one of ordinary skill in the art would have added printing and a non-woven material to an inner surface a box, "especially for aesthetic appeal," at least because the inside of a box is not generally decorated since it generally can't be seen from the outside of the box. Since the final Office Action fails to support the assertion that one of ordinary skill in the art would desire an "aesthetic appeal" for the inside a box, the final Office Action fails to provide any legally proper suggestion or motivation to modify the Chono et al. reference's teachings in the proposed hypothetical manner.

The final Office Action's "aesthetic appeal" assertion is in stark contrast with the guidance of a Federal Circuit decision, which states that

[t]he examiner's conclusory statements . . . do not adequately address the issue of motivation This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to [modify a reference] simply to "[use] that which the inventor taught against its teacher."

In re Lee, 277 F.3d 1338, 1343-44, 2002 U.S. App. LEXIS 855, 61 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 2002) (citation omitted).

In the absence of any suggestion or motivation in the Chono et al. reference itself, and in absence of any legally proper suggestion or motivation from any other

source to support the rejection statement's "aesthetic appeal" assertion, it appears the final Office Action has relied instead on hindsight and the teaching of Applicant's own disclosure in order to modify Chono et al.'s teachings. Applicant respectfully points out, however, that basing an obviousness rejection on hindsight reasoning is improper.

In addition to applying an improper hindsight analysis, the final Office Action cites St. Regis Paper Co. v. Bemis Co. (hereinafter "St. Regis") in an apparent attempt to rely on legal precedent to provide a rationale for supporting the rejection. "[L]egal precedent can provide the rationale supporting obviousness only if the facts in the case [cited] are sufficiently similar to those in the application" and in addition, only if the case relied on is consistent with the current state of the law. M.P.E.P. § 2144. Applicant respectfully submits that the facts of St. Regis and the facts of the present case are not sufficiently similar to provide a *prima facie* case of obviousness, and even if they were, St. Regis is no longer consistent with the current state of the law of obviousness.

In St. Regis, St. Regis Paper Co. ("St. Regis") sued Bemis Co. ("Bemis") for infringing the claims of its patent relating to paper bags. St. Regis, 549 F.2d at 837. In its defense, Bemis alleged that St. Regis' patent was invalid because its asserted claims were obvious based on a prior art patent that disclosed all of the claim limitations except for a limitation relating to the bags having multiple layers. Id. at 838. The Seventh Circuit, finding that bags having multiple layers to achieve the effect of many bags had been known in the bag industry for a number of years, held that the St. Regis' patent claims were obvious and invalid. Id. at 838-39. In rendering its decision, the St. Regis court relied on the obviousness law of that time, which stated that "[u]nless the

combination is 'synergistic, that is, 'result[ing] in an effect greater than the sum of the several effects taken separately," it cannot be patented." Id. at 838 (citation omitted).

Contrary to the present case, St. Regis had merely used multiple layers to strengthen its otherwise unpatentable bags, which even St. Regis acknowledged to be conventional in the bag industry. Id. Applicant's provision, on the other hand, of "a second sheet of non-woven material arranged on [a] second surface of [a] support" is not conventional, as evidenced by the final Office Action's concession that "Chono et al fail to teach adding a second layer . . . to the inner surface of the box" Final Office Action at 5. In fact, the final Office Action fails to identify any evidence that this recited subject matter is conventional. Therefore, rather than merely incorporating a feature acknowledged to be conventional into an otherwise unpatentable claim like St. Regis, Applicant has recited a limitation based on a feature that has not been shown to be conventional.

Furthermore, the state of the obviousness law that led to the St. Regis holding has since been rejected by the Seventh Circuit. See Deere & Co. v. Int'l Harvester Co., 496 F. Supp. 397, 400; 208 U.S.P.Q. (BNA) 158 (C.D. Ill. 1980) (citation omitted). As stated by the U.S. District Court for the Central District of Illinois and in reference to the St. Regis case, the legal premise that "[a] combination patent is not valid unless the combination of elements achieves a synergistic effect" has been "rejected as a criterion for determining obviousness. . . ." Id. (citation omitted.) Therefore, even if the present application has sufficiently similar facts to those of the St. Regis case (which it doesn't), the obviousness law in the case relied on in the rejection statement is no longer valid. Accordingly, the final Office Action's apparent reliance on St. Regis for supporting its

otherwise unsupported assertions about “aesthetic appeal” fail to establish any legally proper suggestion or motivation necessary to establish a *prima facie* case of obviousness.

Conclusions

For at least the reasons set forth above, independent claims 44, 46, and 48 should be allowable. Dependent claims 45, 47, and 49 depend from independent claims 44, 46, and 48, respectively. Consequently, those dependent claims should be allowable for at least the same reasons claims 44, 46, and 48 are allowable. Therefore, Applicant respectfully requests reconsideration of this application, the withdrawal of the outstanding claim rejections, and the allowance of claims 44-49.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant’s undersigned attorney at 571-203-2739.

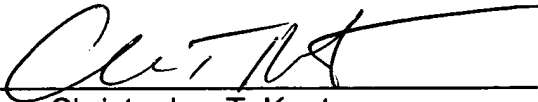
Applicant respectfully submits that the final Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those assertions are specifically addressed herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

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Dated: August 31, 2004

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